

DETAILED ACTION

1. This office action is in response to the amendment filed on October 02, 2009, hereinafter referred to as "amend1009".

Status of Claims

2. Claims 1-3, 8, 9, 13, 16-18, 23, 24, 30-32, 34-41, and 44 have been amended.
3. Claims 4 and 19-22 have been canceled.
4. Claims 5-7, 10-12, 14, 20-22, 25-27, and 29 have been previously canceled.
5. Claims 45-51 have been newly added.
6. Claims 1-3, 8, 9, 13, 15-18, 23, 24, 28, and 30-51 are pending.

Response to Arguments

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112, 1st paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

10. Per claim 41, “receive an identification of the payee prior to transmitting the user interface”, e.g. prior to transmit a user interface presenting at least two payment options, and “wherein the user interface presenting the at least two payment options is at least partially generated based on the determination of whether the payment to the payee would be issued in electronic or paper form” are not disclosed in the original specification.

Claim Rejections - 35 USC § 112, 2nd paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-3, 8, 9, 13, 15, 30-337, 45, 48, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: “receiving by the payment servicing computing system at least one of posting information or deposit information received from the payee for each of the one or more payments” in claim 1. Claims 2-3, 8, 9, 13, 15, 30-337, 45, 48, and 50 are rejected similarly as they depend on claim 1.

13. Claims 1-3, 8, 9, 13, 15, 30-337, 45, 48, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 1 recites "receiving post-issue event information, by a payment servicing computing system comprising one or more computers ... wherein the post-issue event information includes at least one of posting information or deposit information *received* from the payee for each of the one or more payments" (emphasis added). It is unclear to one of ordinary skill whether the recited "receiving post-issue event information" is from the payee given the recitation that part, e.g. "include at least one of posting information or deposit information", is received from the payee. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Additionally, claim 1 has been amended to recite "determining a payment lead time ... based upon the stored information and the respective post-issue event information for at least a subset of the one or more payments" (underlined language represents newly added claim language). The claim language is unclear. For example, prior to the recited determining step, the claim recites "storing information identifying a payment issue time of each of one or more payment to a payee" and "receiving post-issue event information ... associated with each of the one or more payments". Hence, it is unclear which one of the payment(s) represents "for at least a subset of the one or more payments".

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Claims 16 and 44 recite similar feature as described above and are rejected similarly. Claims 2-3, 8, 9, 13, 15, 17-18, 23, 24, 28, 30-43, and 45-51 are rejected similarly as each depends on claims 1, 16, or 44.

15. As per claims 2 and 17, "identifying the post-issue event information of the type having the highest priority level relative to the respective priority levels associated with the plurality of types of post-issue event information" is unclear. Claim 3 also recites "relative to the respective priority levels associated with the plurality of types of post-issue event information" and is rejected similarly.

16. As per claims 3 and 18, the claims have been amended to recite "for which a number of instances of receiving the one of the plurality of types is greater than an associated threshold number". The claim omits the positive recitation of "receiving the one of the plurality of types". Also, it is unclear the recited "receiving" is the same step as "receiving post-issue event information" in the independent claims.

17. As per claims 8 and 23, the claims are dependent on claim 1 or claim 16. Independent claims 8 and claim 16 recite "wherein the post-issue event information for the one or more payments includes posting information and deposit information". This is contradictory to the claim element(s) recited in the independent claims, "wherein the post-issue event information includes at least one of posting information or deposit information".

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18. As per claim 9, the recited “wherein the one or more payments is a plurality of payments” is unclear. For example, wherein one payment is a plurality of payments is unclear.

19. Claims 9 and 24 are missing a step of “determining whether the respective post-issue event information comprises posting information for each of the plurality of payments or deposit information for each of the plurality of payments”.

Moreover, claims 9 and 24 recite “for each of the plurality of payments” and “for the plurality of payments”. It is unclear whether recited “each of the plurality of payments” and/or “for the plurality of payments” represent “each of one or more payments to a payee” recited in claims 1 and 16.

Furthermore, the recited “wherein the respective post-issue event information for each of the plurality of payments comprises **the same** one of posting information or deposit information” is unclear. Same suggest at least two elements, and it is unclear what those elements are.

Additionally, claims 9 and 24 recites “wherein posting information identifies ... deposit information identifies ...”. Encarta World English Dictionary, copyright 2009 by Microsoft Corporation, defines term identify as “to recognize somebody or something and to be able to say who or what he, she, or it is”. Hence, it is unclear how information which is considered as non-functional descriptive material can perform active verb of “identifies”. Claims 15 and 43 are rejected similarly.

Continuing on claims 9 and 24, the claims are dependent on claims 1 or 16 respectively. Claim 1 and 16 recite “determining a payment lead time ... based upon

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the stored information and the respective post-issue event information for at least a subset of the **one** or more payments". Claims 9 and 24, however, are contradictory to this since the claims recite "wherein the payment lead time is based at least partially upon the determined average period" and "determining average period ... based on ... **plurality of payments**".

Claim 31 is rejected similarly as described above since it depends on claim 9.

20. As per claims 31 and 39, the recited term "a predetermined depositing adjustment period" is unclear. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

21. Per claims 35, 36, and 41, the claims recite "determination of whether the payment to the payee would be issued in electronic or paper form" without positively reciting the step of determining. The claim merely recites "processing the identification of the payee **to determine** whether the payment to the payee would be issued in electronic or paper form".

22. As per claims 38 and 39 are dependent on claim 19 which has been canceled. For the prosecution purpose, claims 38 and 39 will be read as dependent on claim 16 only.

Claims Interpretation

23. The Applicant has cited the reference(s) in the instant application in order to show support for “means for” language in claim 44 in amend0409 (see amend0409, page 15, ¶02).

24. In reference to the “algorithm and step-by-step process” example (see amend0409, page 15, ¶02), the subject matter is directed toward non-statutory subject. The Examiner will interpret the “algorithm and step-by-step process” to be computer-implemented algorithm stored in the memor(ies) 305, when executed by the processor(s) 303 causes the processor(s) as for “determining ...”. **The Applicant is advised to clarify if the Examiner’s interpretation is incorrect in the immediate subsequent amendment/reply.**

25. Based on the applicant’s remark in amend0409 (see amend0409, page 15, ¶02) along with the Examiner’s interpretation (see above) and for prosecution purpose, the following is the list of structure(s) that will be interpreted as structure(s) supporting the “means for” in claim 44:

- Data repository 310 and the respective databases 310A, 310B, 310C in Figure 3 as structure supporting “means for storing ...”;
- Communication interface 315, Figure 3 in communication with the network 202, Figure 2 as structure supporting “means for receiving ...”; and
- Algorithm stored in the memor(ies) 305, when executed by the processor(s) 303 causes the processor(s) as “means for determining ...”.

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26. In regards to the phrase "**associating/associate/associated**" in the claims, Webster's New Collegiate Dictionary, Copyright 1981 defines associate as "to bring together in any various ways (as in memory or imagination)".

27. In regards to the phrase "**lead time**" in the claims, Webster's New Collegiate Dictionary, Copyright 1981, defines term, lead time, as "the period between the decision to begin a process ... and the completion of the process".

28. In regards to the phrase "**at least partially**" in the claims, "at least partially" will be interpreted as "at least" in light of the Applicant's assertion on the claim language (see Amend1009, page 17, ¶105).

29. In regards to the phrase "**posting information**" in the claims, Webster's New Collegiate Dictionary, Copyright 1981, defines term, post, as "to make transfer entries".

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 1, 8, 9, 13, 16, 23, 24, 28, 30, 31, and 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's Background of the Invention in the instant application (hereinafter "Background") in view of US Patent No. 6,292,789 (hereinafter "Schutzer") in further view of US Patent Application No. 2003/0055783, (hereinafter "Cataline").

32. Per claims 1, 16, and 44, Background discloses a computer-implemented method, comprising:

- storing information identifying a payment issue time of each of one or more payments to a payee, wherein each of the one or more payments have a same payment mechanism (see ¶0020, storing of payment history; ¶0024; ¶0029; and ¶0030; wherein clause merely describes payment and do not limit the step of storing);
- receiving post-issue event information, by a payment servicing computing system comprising one or more computers, associated with each of the one or more payments; (see ¶0032; ¶0033; ¶0037; ¶0040-¶0049; ¶0053, service provider system);

33. Background does not specifically disclose wherein the post-issue event information includes at least one of posting information received from the payee for each of the one or more payments. However, Schutzer discloses a method of acknowledging received payment by the payee, e.g. biller, (see col. 20, line 39—col. 21, line 14). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features of acknowledgement of payment receipt from the payee as taught by Schutzer to Background in order to provide evidence of payment receipt.

34. While Background discloses a payment lead time, e.g. electronic payment and non-electronic payment, for payment to the payee issued on behalf of a payor (¶0046),

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the Background and Schutzer do not disclose determining a payment lead time, based upon the stored information and the post-issue event information, to complete a future payment to the payee issued on behalf of a payor. However, one of ordinary skill in the art at the time of the invention would have recognized that the predictable result based on the definition of lead time, the period between the decision to begin a process ... and the completion of the process (in this case period between a payment issue time and completion of payment), is to determine the payment lead time based upon the stored information, e.g. a payment issue time, and the post-issue event information, e.g. recordation of date/time of completion of payment process.

35. The background does not specifically disclose associating the payment lead time with the payee. The Background, however, discloses a service provider having information that enables remittance, e.g. payment, to be handled in some “improved/optimal fashion” and setting up of payee list including lead time (see ¶0009; ¶0048 - ¶0049) Hence, the predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) is to associate the determined payment lead time with the payee in order to enable payment in improved/optimal fashion.

36. In further reference to claims 16 and 44, the Background discloses Electronic Billing and Payment and electronic Biller Service Provider (see ¶0040). The Electronic Billing and Payment and electronic Biller Service Provider necessarily teach a computer system with a memory, a communications interface, and a processor. Furthermore, Schutzer teaches a memory, a communication interface, and a processor (see Fig. 1; col. 5, lines 30-33; col. 25, lines 1 and 2; claim 1; claim 9).

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37. As per claims 8, 9, 23, 24, 30, and 31 the claims are directed towards determining post-issue information and determining average period based on the payment issuance time to post-issue information, e.g. posting time. As Background discloses a method of calculating lead time, e.g. standard lead time, based on historical event, e.g. common knowledge, and as combined prior art teach determination of payment lead time based on process begin time and end time, payment issuance time, and post-issue information, a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) is to determine the payment lead time based upon the stored information, e.g. a payment issue time, and the post-issue event information using available mathematical algorithm, e.g. determining average and factoring in deviation, for predicting the payment lead time for best results (*Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)). Additionally, optional or conditional elements “if” do not narrow the claims because they can always be omitted. See MPEP §2106 II C and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006).

38. As per claims 13 and 28, the Background teaches receiving a payment request to pay the payee on behalf of the payor (see ¶0005), the payment request including information identifying a payment due date (see ¶0045); and issuing a payment to the payee at the determined time (see ¶0045; ¶0046). Prior art teach determining a time to issue a payment to the payee to fulfill the payment request by the due date based at least partially upon the determined payment lead time associated with the payee (see

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above analysis on prior art in reference to determined payment lead time associated with the payee; Background: ¶0045; ¶0046).

39. As per claims 45, 46, and 47, prior art discloses wherein at least part of the respective post-issue event information for at least some of the one or more payments further includes settlement information (see ¶0032; ¶0033; ¶0037).

40. As per claim 48 and 49, prior art discloses wherein the payment mechanism comprises electronic payment mechanism (see Background: ¶0004; ¶0005; ¶0007).

41. As per claims 50 and 51, the claims are similar to claims 9 and 24 and are rejected similarly as the difference in claims are using settlement information to determine payment lead time.

42. Claims 2, 15, 17, 32-37, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's Background of the Invention in the instant application (hereinafter "Background") in view of US Patent No. 6,292,789 (hereinafter "Schutzer") in further view of US Patent Application No. 2003/0055783, (hereinafter "Cataline").

43. As per claims 2 and 17, the prior art do not specifically disclose wherein the post-issue event information includes a plurality of types of post-issue event information and each of the plurality of types of post-issue event information is associated with a priority level, and further comprising: identifying the post-issue event information of the type

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having the highest priority level relative to the respective priority levels associated with the plurality of types of post-issue event information; wherein the payment lead time is determined based at least partially upon the stored information and the post-issue event information having the highest priority level. However, Cataline discloses assigning a priority level, i.e. various weighting, and using the priority level in making determination or predicting, e.g. most effective settlement (see ¶0141). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of Cataline, technique of utilizing priority level, to Background and Schutzer as each are related to payment. One of ordinary skill in the art would have recognized that utilizing weighting factor would provide flexibility in calculating the payment lead time.

44. As per claims 32 and 40, Cataline discloses a system and methods comprising transmitting a user interface presenting at least two payment options for paying the payee, (see Cataline, ¶0045, user interface; Fig. 3, various drop down box for presenting payment options); receiving a selection of a first payment option (see Cataline, ¶0045, user interface; Fig. 3, various drop down box for presenting payment options); and issuing payment to the payee in accordance with the first payment option (see Cataline, ¶0045, user interface; Fig. 3, various drop down box for presenting payment options; ¶004 performing payment; Fig. 6, payment forwarding portion 520). The prior art, e.g. discussed in claim 1, disclose determining the payment lead time associated with the payee. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of providing payment

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options using user interface in order to present the determined payment lead time associated with the payee and to provide flexible options to a payor.

45. As per claims 15 and 43, the claim is directed towards the payment option information, specifically a cost to the payor associated with issuing payment. The subject matter is non-functional descriptive material that does not affect the recited steps, e.g. transmitting, receiving, issuing payment, hence will not move to distinguish from the prior art. As prior art teaches transmitting a user interface presenting two options (see above), prior art continues to read on the claim. See *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II.

46. As per claim 33, the Background discloses a future-dated payment option (see ¶0045).

47. As per claim 34, the prior art discloses an electronic payee and immediate payment and posting (see Background ¶0005; ¶0007; ¶0011; ¶0017; ¶0027; ¶0043; ¶0046; ¶0049; ¶0044; ¶0047; see Cataline ¶0053).

48. As per claims 35 and 41, Background further discloses receiving an identification of the payee; processing the identification of the payee to determine whether payment would be issued in electronic or paper form (see ¶0048-¶0049). In regards to wherein

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the user interface presenting the at least two payment options is at least partially generated based on the determination of whether payment for the payee would be issued in electronic or paper form, the prior art teach user interface, e.g. GUI and Web-based interface (see Background ¶¶0049; see Cataline Fig. 3).

49. As per claim 36, the prior art further disclose receiving a payment amount (see Background ¶¶0005).

50. As per claims 37 and 42, the prior art also disclose receiving a due date wherein issuing payment to the payee is based at least partially upon the due date (see Background ¶¶0045; ¶¶0046).

51. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's Background of the Invention in the instant application (hereinafter "Background"), US Patent No. 6,292,789 (hereinafter "Schutzer"), US Patent Application No. 2003/0055783, (hereinafter "Cataline") in view of US Patent No. 6,658,393 (hereinafter "Basch").

52. As per claims 3 and 18, the combined prior art teach utilizing priority level in calculating the payment lead time as described above. The prior art, however, do not specifically disclose wherein: the payment lead time is determined based at least partially upon the stored information and the one of the plurality of types of post-event

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information having the highest priority level, relative to the respective priority levels associated with the plurality of types of post-issue event information, for which a number of instances of receiving the one of the plurality of types is greater than an associated threshold number. However, Bach discloses determination based on a number of instances greater than an associated threshold number, i.e. data sampling (see col. 11, lines 34-60, data sampling and predictive modeling using various technique; Abstract). It would have been obvious to one of ordinary practitioner at the time of the invention to utilize the old and well known technique of establishing a threshold number of data samples with the motivation of providing accuracy.

53. Claims 16-18, 23, 24, 28, 40-43, 46, 49, and 51, the claims are directed towards apparatus, e.g. a memory, communications interface, processor. The claims, however, recite intended use of apparatus that do not limit the claimed apparatus, e.g. "operable to execute" in claim 16. See MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). The claims also recite non-functional materials, e.g. post-issue event information in claim 16, that do not limit the structure of the recited apparatus. See *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II.

Conclusion

54. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Application No. 2004/0215560 that discloses computer based payment system and method; US Patent No. 5,483,445 that discloses billing consolidation system; US Patent 5,220,501 that discloses remote electronic billpay; US Patent Application No. 2003/0225642 that discloses system and method for transaction triggered cycling of financial account; US Patent Application No. 2004/0148234 discloses displaying of payment related information including payment received date; US Patent No 5,832,460 discloses payment reconciliation; US Patent Application No. 2002/0019808 discloses bill payment and reconciliation; US Patent Application No 2003/0225690 discloses billing process and system using feedbacks between biller and billee for reconciling A/R records.

55. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

56. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

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Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685